

REMARKS

The Amendment

Claim 1 is amended to delete Formulae I, III and IV in response to the Restriction Requirement.

Claims 1, 7-13 and 15 are amended to proper claim language, which clarifies the meaning of the claims.

No new matter is added in any of the above amendments. The Examiner is requested to enter the amendment and reconsider the application.

The Remarks

Election/Restriction

The Examiner states that Applicant has elected without traverse of Group II, wherein X is oxygen, $m+n=2$, and B and B' are a pyrimidine of general formula IIb.

Although Applicant has elected X = oxygen; $m+n = 2$; B and B' are each independently a pyrimidine of general Formula IIb in response to the species election requirement, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR §1.141.

35 U.S.C. §112, Second Paragraph Rejection

Claims 1-2, 4, 7-10, 12, 13, and 15 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner states that the term "effective mount" has been held to be indefinite when the claim fails to state the function which is to be achieved and more than one effect can be implied from the specification or the relevant art. Applicant has amended Claim 1 to recite that whereby said preparation is effective in enhancing the drainage of the lacrimal system in the eyes in a subject. Applicant has also amended Claim 15 to recite an effective drainage-enhancing amount.

The Examiner states that there is insufficient antecedent basis for the limitations drawn to the administration of the compound to places other than the eyes in claims 9, 10, 12, and 13.

Applicant has amended the claims to clarify the claim language. The dinucleotide compound is indeed administered to the eyes via systemic absorption and circulation.

In view of the amendment, the Examiner is requested to withdraw the §112, second paragraph rejection of Claims 1-2, 4, 7-10, 12, 13, and 15.

Double Patenting Rejection

Claims 1, 2, 4, and 7-15 are rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of Claims 1-9 of prior U.S. Patent No. 5,900,407. The rejection is traversed because the claims in the present application are different from those in the '407 Patent.

The present invention is directed to a method of enhancing drainage of the lacrimal system. For example, the method enhances clearance of the nasolacrimal duct for any reason, including, but not limited to, treatment of nasolacrimal duct obstruction. Nasolacrimal duct obstruction is defined to include both primary and secondary acquired nasolacrimal duct obstruction and pediatric nasolacrimal duct obstruction (see specification at page 5, lines 11-16 and page 6, lines 22-27).

The '407 Patent is directed to a method of stimulating tear secretion from lacrimal tissues. Such method is useful to treat dry eye disease.

A method of enhancing drainage of the lacrimal system is not the same as a method of stimulating tear secretion from lacrimal tissues; each method is useful to treat distinct diseases.


Therefore, the 35 U.S.C. §101 rejection of Claims 1, 2, 4, and 7-15 should be withdrawn.

CONCLUSION

Applicants believe that the application is in good and proper condition for allowance. Early notification of allowance is earnestly solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 463-8109.

Respectfully submitted,

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